

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
CZEKAJ, et al.

Examiner: T. McKenzie

Art Unit: 1624

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APR 13 2007

Application No.: 10/686,871

Filed: October 16, 2003

Title: N-ACYLPYRROLIDIN-2-
YLALYKLBENZAMIDINE
DERIVATIVES

TELEFAX CERTIFICATE

I hereby certify that this correspondence is being
transmitted via facsimile to the Commissioner for
Patents, Alexandria, VA 22313, on 571 273 8300

April 13, 2007

Date of Transmission

Signature

Mr. PAUL SHANOSKI
Mail Stop Petition
Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO DECISION ON PETITIONS

Dear Sir:

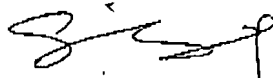
This paper is in response to the decision mailed December 14, 2006 (hereinafter the Decision), on two petitions concurrently filed on September 5, 2006, pursuant to 37 C.F.R. § 1.47(A) and 1.183, requesting the acceptance of a declaration without the signature of one of the joint inventors, and the waiver of the requirement for a new declaration under 37 C.F.R. § 1.67(a), in connection with the above-identified patent application.

The petitions were rejected as a complete copy of the present application was not sent to the non-signing inventor. (See the Decision, page 5). The undersigned attorney thereafter sent a complete copy of the present application and a copy of an unexecuted Declaration to the non-signing inventor, Mr. Scott Klein, on March 5, 2007. Surprisingly, Mr. Klein timely returned the executed Declaration to the undersigned attorney. Thus, pursuant to the telephone conversation that the undersigned attorney had with Mr. Paul Shanoski, the attorney at Office of Petitions responsible handling this matter, on April 5, 2007, Applicants submit concurrently herewith the

executed Declaration by Mr. Klein, and respectfully request withdrawal of the aforesaid petitions.

Applicants also file concurrently herewith a Petition for Extension of Time for two months, or until April 16, 2007. The Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 18-1982 in the name of Aventis Pharmaceuticals, Inc.

Respectfully submitted,



Dated: April 13, 2007

Jiang Lin, Registration No. 51,065
Attorney for Applicants

Sanofi-aventis U.S. LLC
Patent Department
Route #202-206 / P.O. Box 6800
Bridgewater, New Jersey 08807-0800
Telephone: 908-231-3582
Telefax: 908-231-2626

Docket No. DEAV1999/S005 US CIP1

DEAV1999/S005 US CIP

ASSIGNMENT AND AGREEMENT

For value received and intending to be legally bound, I/we, the undersigned joint inventor(s) (Assignor(s)), sell, assign and transfer to **Aventis Pharmaceuticals Inc.** (Assignee), 300 Somerset Corporate Boulevard, Bridgewater, New Jersey 08807-2854, United States of America, and its successors, assigns and legal representatives, the entire right, title and interest in and to my/our invention and any improvements thereon for all countries of the world, relating in and to the application for United States Letters Patent therefor, assigned Attorney Docket No. **DEAV1999/S005 US CNT** and (if filed prior to the execution hereof) filed on October 16, 2003, as Serial No. 10/686,871, entitled

**N-ACYLPYRROLIDIN-2-YLALKYLBENZAMIDINE
DERIVATIVES AS INHIBITORS OF FACTOR XA**

and all the rights and privileges, including any and all benefits under the International Convention for the Protection of Industrial Property, including the right to claim priority based on said United States application, and under any and all Letters Patent which may be granted therefor, and all right, title and interest in and to every patent application filed or to be filed on said invention in any other country or patent organization, including continuations, divisions, renewals, revivals, and any substitute applications of said United States application, and any and all patents which may issue thereon, and any reissues, pipelines and extensions, and governmental exclusivity rights of the same.

I/we authorize and request competent authorities to grant and issue any and all patents on said invention to said assignee or its successor, assigns and legal representatives, or to such nominees as said assignee may designate.

I/we agree that, when requested, I/we will, without charge to said assignee but at its expense, sign all papers, take all rightful oaths, and do all acts which may be necessary, desirable or convenient for securing and maintaining patents for said invention in any and all countries and for vesting title thereto in said assignee, its successors, assigns, legal representatives or nominees.

I/we covenant with said assignee, its successors, assigns and legal representatives, that the rights and property herein conveyed are free and clear of any encumbrance, and that I/we have full right to convey the same as herein expressed.

Signed at _____ on this _____ day of _____, 2007.
(City, State and Nation)

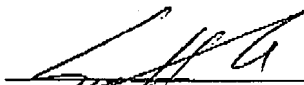
Signature: _____

Inventor's Name: Mark Czekaj

Residential Address: 3897 Charter Club Drive
Doylestown, PA 18901

DEAV1999/S005

Signed at Collegeville, PA ^{USA} on this 12TH day of MARCH, 2007.
(City, State and Nation)

Signature: 

Inventor's Name: Scott I. Klein

Residential Address: 560 Locust St.
Collegeville, PA 19426

Signed at _____ on this _____ day of _____, 2007.
(City, State and Nation)

Signature: _____

Inventor's Name: Henry W. Pauls

Residential Address: 28 New York Avenue
Flemington, NJ 08822

UNITED STATES OF AMERICA

**DECLARATION
FOR PATENT APPLICATION**

As a below named inventor(s), I/We hereby declare that:

My/Our residence(s), post office address(es) and citizenship(s) are as stated below my name(s).
I/We verily believe I am/we are the original, first and sole/joint inventor(s) of the subject matter which is claimed
and for which a patent is sought on the invention entitled:

N-ACYLPYRROLIDIN-2-YLALKYLBENZAMIDINE DERIVATIVES

and the specification of which ☐ is attached hereto (Aventis Docket No. DEAV1999/S005 US CIP)
(check one) ☒ was filed on **October 16, 2003** as U.S. Application Number **10/686,871**
and was amended on (if applicable).
☐ was described and claimed in PCT Int'l Application Number filed on
and as amended under PCT Article 19 on (if any).

I/We hereby state that I/We have reviewed and understand the contents of the above identified specification,
including the claims as amended by any amendment referred to above.
I/We acknowledge the duty to disclose to the U.S. Patent and Trademark Office all information known to me/us to
be material to patentability as defined in 37 C.F.R. 1.56.

☒ I/We hereby claim foreign priority benefits under Title 35, United States Code §119(a)-(d) or 365 (b) of any foreign
application(s) for patent or inventor's certificate, or 365(a) of any PCT international application which designated at
least one other country other than the United States of America, listed below and having a filing date before that of
the application on which priority is claimed. I/We have also identified below any foreign application for patent or
inventor's certificate having a filing date before that of the application on which priority is claimed:

Foreign Priority: 9930540.1 Great Britain 23/December/1999
Number Country Day/Month/Year Filed

Prior Foreign Appln(s): Number Country Day/Month/Year Filed

☒ I/We hereby claim the benefit under Title 35, United States Code §119(e) of any United States Provisional
application(s) listed below:

60/164,621 November 10, 1999
Number Filing Date

☐ I/We hereby claim the benefit under Title 35, United States Code §120 or 365(c) of any United States
application(s) or international application designating the United States listed below and, insofar as the subject
matter of each of the claims of this application is not disclosed in the prior United States application in the manner
provided by the first paragraph of Title 35, United States Code §112, I/We acknowledge the duty to disclose
information which is material to patentability as defined in Title 37, Code of Federal Regulations §1.56 which
became available between the filing date of the prior application and the national or PCT international filing date of
this application.

Application Serial No. Filing Date Status (Patented, Pending)

I/We hereby declare that all statements made herein of my own knowledge are true and that all statements made on information
and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements
and the like so made are punishable by fine or imprisonment, or both, under Title 18, United States code §1001, and that such
willful false statements may jeopardize the validity of the application or any patent issued thereon.

Inventors(s): ☒ Additional names and signatures are attached.

1. Full name: Mark CZEKAJ

Signature: _____

Date: _____

Country of Citizenship: US

Residence: Doylstown, PA
(City and State/City and Country only)

P. O. Address: 3897 Charter Club Drive
Doylstown, PA 18901

2. Full name: Scott L. KLEIN

Signature: _____

Date: 3/12/07

Country of Citizenship: US

Residence: Collegeville, PA
(City and State/City and Country only)

P. O. Address: 560 Locust St
Collegeville, PA 19426

APR. 13. 2007 11:35AM

AVENTIS US PAT DEPT

NO. 1061 P. 3

3. Full name: Henz W. PAULS
Signature: _____
Date: _____
Country of Citizenship: CANADA
Residence: Ontario, CANADA
(City and State/City and Country only)
P. O. Address: 460 Fourth Line
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Bridgewater, NJ 08807-0800
Telephone (908) 231-3582
Telefax (908) 231-2626

Aventis Docket No. DEAV1999/S005 US CIP

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DEC 18 2006

PATENT DEPT.



File Petitions(Renewed)-2/14/07

UNITED STATES PATENT AND TRADEMARK OFFICE

Deadline To File Renewed Petitions w/5th EOT- 11/14/07

DUE DATE

2/14/07 - 2/14/07

DKTD BY

Jas 12/19/06

ATTY

J. LIN

 COMMISSIONER FOR PATENTS
 UNITED STATES PATENT AND TRADEMARK OFFICE
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 ALEXANDRIA, VA 22313-1450
 WWW.USPTO.GOV

Paper No. None

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 BRIDGEWATER NJ 08807

COPY MAILED

DEC 14 2006

OFFICE OF PETITIONS

In re Application of :
 Mark Czekaj, Scott I. Klein, :
 and Heinz W. Pauls :
 Application No. 10/686,871 :
 Filing Date: October 16, 2003 :
 Attorney Docket Number: :
 DEAV1999S005USCIP :
 Title: N-ACYLPYRROLIDIN-2- :
 YLALKYLBENZAMIDINE DERIVATIVES :
 AS INHIBITORS OF FACTOR XA :

DECISION ON TWO PETITIONS
 UNDER 37 C.F.R. §§ 1.47(A)
 AND 1.183

Background

This is a decision on the two petitions concurrently filed on September 5, 2006 pursuant to 37 C.F.R. §§ 1.47(a) and 1.183, requesting the acceptance of a declaration without the signature of one of the joint inventors, and the waiver of the requirement for a new declaration under 37 C.F.R. §1.67(a).

The present application was filed on October 16, 2003, and is a continuation-in-part of Application number 10/143,190. The declaration which was provided on filing was associated with this parent application, and was executed by each of the three joint inventors.

On January 25, 2005, Petitioner submitted a declaration which is associated with the present application and does not list Mr. Klein as an inventor. Petitioner further submitted an explanation that Messrs. Czekaj, Klein, and Pauls invented the subject matter disclosed in the parent application, however Mr.

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Klein subsequently left the employ of the assignee and was not involved in the development of the subject matter which comprises the new matter that is disclosed in the present continuation-in-part child application.

On January 31, 2006, a non-final action was mailed, which indicated that a supplemental declaration pursuant to 37 C.F.R. §1.67 would be required, and that the supplemental declaration should be associated with the present application as well as executed by each of the three joint inventors.

The petition under 37 C.F.R. §1.183

The petition fee has been charged to Petitioner's Deposit Account, as authorized in the petition.

In short, Petitioner wishes to have the Office waive the requirement that Mr. Klein sign the supplemental declaration which is associated with the present application.

A discussion follows.

Applicable Rules

37 C.F.R. §1.47(a) sets forth, in toto:

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(g), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

37 C.F.R. §1.63(a)(1) and (2) set forth, in toto:

(a) An oath or declaration filed under § 1.51(b)(2) as a part of a nonprovisional application must:

(1) Be executed, i.e., signed, in accordance with either § 1.56 or § 1.68. There is no minimum age for a person to be qualified to sign, but the person must be competent to sign, i.e., understand the document that the person is signing;

(2) Identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial;

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37 C.F.R. §1.67(a) sets forth, *in toto*:

(a) The Office may require, or inventors and applicants may submit, a supplemental oath or declaration meeting the requirements of § 1.63 or § 1.162 to correct any deficiencies or inaccuracies present in the earlier filed oath or declaration.

(1) Deficiencies or inaccuracies relating to all the inventors or applicants (§§ 1.42, 1.43, or § 1.47) may be corrected with a supplemental oath or declaration signed by all the inventors or applicants.

(2) Deficiencies or inaccuracies relating to fewer than all of the inventor(s) or applicant(s) (§§ 1.42, 1.43 or § 1.47) may be corrected with a supplemental oath or declaration identifying the entire inventive entity but signed only by the inventor(s) or applicant(s) to whom the error or deficiency relates.

(3) Deficiencies or inaccuracies due to the failure to meet the requirements of § 1.63(c) (e.g., to correct the omission of a mailing address of an inventor) in an oath or declaration may be corrected with an application data sheet in accordance with § 1.76.

(4) Submission of a supplemental oath or declaration or an application data sheet (§ 1.76), as opposed to who must sign the supplemental oath or declaration or an application data sheet, is governed by § 1.33(a)(2) and paragraph (b) of this section.

37 C.F.R. §1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

[47 FR 41273, Sept. 17, 1982, effective Oct. 1, 1982; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

Analysis

In order to submit a grantable petition under 37 C.F.R. §1.183, Petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

Petitioner has not neither asserted nor established that either condition exists in this case. The circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rules.

The existence of an extraordinary situation

The PTO has a well established and well publicized practice by

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which practitioners may seek the acceptance of a declaration which has been executed by less than all of the joint inventors listed thereon. Petitioner must submit the filing fee, the fee associated with the late submission of the petition (if not presented with the application on filing), a statement of the last known address of the non-signing inventor; proof that either a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application, or the non-signing inventor cannot be found or reached after diligent effort, and a statement that these efforts were not successful, and; a declaration which complies with 37 C.F.R. §1.63.

It is not clear what is extraordinary about a situation where a joint inventor has left the employ of the assignee, and has refused to execute a supplemental declaration.

The question of whether justice requires the waiver of the rule:

Pursuant to Rule §1.47(a), the application may be made by the other signing inventors on behalf themselves and the non-signing inventor.

As such, an avenue exists by which Petitioner may escape this quandary, and it follows that justice does not require that Rule §1.67(a) be waived. Furthermore, it is noted that with the present petition, Petitioner has included a petition under 37 C.F.R. §1.47(a).

Conclusion

The petition under 37 C.F.R. §1.183 is **DISMISSED**.

The petition under 37 C.F.R. §1.47(a):

With the petition pursuant to Rule §1.47(a)¹, Petitioner has asserted that the non-signing inventor orally refused to sign the supplemental declaration.

1 A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$200;
- (2) a surcharge of either \$65 or \$130, if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(f);
- (3) a statement of the last known address of the non-signing inventors;

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Decision on Petitions pursuant to 37 C.F.R. §§1.47(a) and 1.183

Both the petition fee and the surcharge associated with the late submission of the present petition have been charged to Petitioner's Deposit Account, as authorized in the petition.

With the present petition, Petitioner has submitted a declaration which complies with 37 C.F.R. §1.63.

As such, requirements (1), (2), and (5) of Rule §1.47(a) have been met.

Regarding the third requirement, petitioner has failed to include a statement of the last known address of the non-signing inventor².

Regarding the fourth requirement, it does not appear that a complete copy of the present application was sent to the non-signing inventor. It follows that one cannot refuse to sign something which one has not been presented with. A refusal by an inventor to sign a declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers associated with the present application before a petition under Rule §1.47(a) is granted, since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed³.

Conclusion

The petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a)

(4) proof that either:

- a) a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application, or
- b) the non-signing inventor cannot be found or reached after diligent effort, and a statement that these efforts were not successful;

(5) a declaration which complies with 37 CFR §1.63.

² See MPEP 409.03(e).

³ In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

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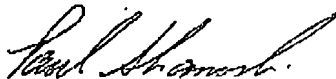
Decision on Petitions pursuant to 37 C.F.R. §§1.47(a) and 1.183

are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §§1.47(a) and/or 1.183." This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition(s) should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail⁴, hand-delivery⁵, or facsimile⁶.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225⁷. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

4 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

5 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

6 (571) 273-8300- please note this is a central facsimile number.

7 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).